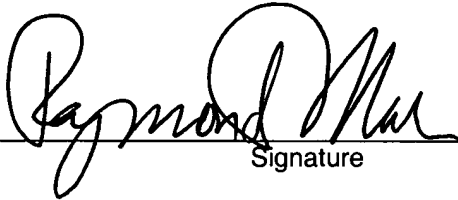




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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		2018-460
	Application Number	Filed
	09/982,988	October 22, 2001
	First Named Inventor	
	MAKI et al.	
	Art Unit	Examiner
	3661	Broadhead, B.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> Applicant/Inventor</p> <p><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> Attorney or agent of record 41,426 (Reg. No.)</p> <p><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p>		



Signature
Raymond Y. Mah

Typed or printed name

703-816-4044
Requester's telephone number

June 19, 2006
Date

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**STATEMENT OF ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

The following listing of clear errors in the final rejection are responsive to the final rejection mailed January 17, 2006 and the Advisory Action mailed May 3, 2006.

Page 4, lines 16-25 of the specification does not constitute "admitted prior art" and thus the final Office Action fails to establish a *prima facie* case of obviousness with respect to claims 2-9, 11-22, 24-28, 30-32 and 34-35 under 35 U.S.C. §103 in view of Shimizu et al (EP '423, hereinafter "Shimizu") in view of Schofield et al (U.S. '989, hereinafter "Schofield") in further view of admitted prior art.

Page 4, lines 1-5 of the final rejection states that "Applicant admits the prior art discloses a relationship between said malfunction information and said selected condition of one of said plurality of malfunction-information storing objects being different from that of another one of said plurality of malfunction-information storing objects on lines 16-25, on page 4 of the specification." Section 11 of the Advisory Action echoes the above statement of the final rejection.

The above statements in the final rejection and Advisory Action are incorrect. There is no explicit or implicit admission that page 4, lines 15-25 of the specification constitutes applicant admitted prior art.

Instead of describing admitted prior art, page 4, lines 15-25 of the specification describes disadvantages of related art and desirable operation of exemplary embodiments of the present invention proposed by the inventors. In particular, the summary of the invention section of the present application explicitly states "The present invention addresses the disadvantages discussed in the above sections (1)-(3)...(emphasis added)." (See page 7, lines 6-8 of the specification). Moreover, the detailed description of the

invention section of the application states “Thus, the reusability of the self-diagnosis program is improved, and the disadvantage discussed in the above section (1) can be dissolved,” (see page 26, lines 5-7), “Because of this reason, the reusability of the self-diagnosis program is improved, and the disadvantage discussed in the above section (2) can be dissolved,” (see page 27, lines 6-8), and “As a result, the reusability of the self-diagnosis program is improved, and the disadvantage discussed in the above section (3) can be dissolved,” (see page 27, lines 19-21). These portions of the specification thus describe that sections (1)-(3) (page 4, lines 15-25 of the specification is part of section (1)) are not prior art, but rather disadvantages overcome by the desired operation of the present invention.

Page 4, lines 15-25 of the specification is thus not applicant admitted prior art as alleged in the Office Action. Rather, this section of the specification discusses the disadvantages of related art and the desirable operation of the MIL proposed by the inventors of the present application which is not taught by the prior art, e.g., Japanese Unexamined Patent Publication No. 7-190897 (corresponding to U.S. Patent No. 5,671,141). Again, there is no explicit or implicit admission that page 4, lines 15-25 of the specification constitutes prior art. Indeed, other portions (see page 7, lines 6-8, page 26, lines 5-7, and page 27, lines 6-8 and 19-21) of the specification explicitly disclose that sections (1)-(3) describe disadvantages of related art which are addressed by example embodiments of the present invention. Page 4, lines 15-25 of the specification are included in section (1).

Even if the teachings of Shimizu and Schofield and page 4, lines 15-25 of the specification (which again does not disclose prior art) were combined as proposed by the Office Action, the combination would not have taught or suggested all of the claim

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limitations. For example, the combination would not have taught or suggested "a relationship between said malfunction information and said selected condition of one of said plurality of malfunction-information storing objects being different from that of another one of said plurality of malfunction-information storing objects," as required by independent claim 35. Similar, but not necessarily identical, comments apply to independent claims 7, 11, 14, 20 and 24.

In view of the forgoing, Applicant submits that there is no proper basis for rejection of claims 2-9, 11-12, 24-28, 30-32 and 34-35 under 35 U.S.C. §103 over Shimizu, Schofield and page 4, lines 16-25 (which in view of the above discussion does not constitute prior art) of the specification .

Applicant therefore respectfully requests that the pre-appeal panel find that the application is allowable based on the existing claims and that prosecution on the merits should be closed.

Respectfully submitted,

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By: 

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